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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,700	03/22/2005	Ralf Noerenberg	268093US0PCT	7149
22850 7590 01/08/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER SOLOLA, TAOFIQ A	
			ART UNIT 1625	PAPER NUMBER
			NOTIFICATION DATE 01/08/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary

Application No.

10/528,700

Applicant(s)

NOERENBERG ET AL.

Examiner

Taofiq A. Solola

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 19 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-27 and 29-59 is/are pending in the application.
- 4a) Of the above claim(s) 1-20, 29-32 and 40-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 21-27, 33-39 and 44-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3</u> . | 6) <input type="checkbox"/> Other: _____ |

Claims 1-59 are pending in this application

Claims 29-32, 40-43, 21-27 (in part), 33-39 (in part), 44-59 (in part) are drawn to non-elected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 21-27, 33-39, 44-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

All reference to the phraseologies "degree of branching (number of methyl per molecule) from 0.2 to 1.6"; the mixture of R1X in claim 26 render claims 21-26, 33-39, 44-59; "n has numerous values" and the last three lines in claim 25 are unclear and confusing, and therefore the claims are indefinite. According to the specification, pages 7-8, degree of branching relates to branched alcohol and the mixture of R1X relates to impure (technical grade) alcohols that may be used in the preparation of compounds of formula (I) instead of a linear or a pure alcohol respectively. The specification fails to disclose any advantage or significance for using the alcohols. Also, these are acquired reagents not applicant's invention. It is not possible for methyl to occur in fractions and the phrase "numerous values of n" is indefinite. Therefore, these characteristics of the alcoholic reagents have no patentable significance.

In claim 26 when n is 1-5 as defined in 21, $n\text{-C}_5\text{H}_{11}$ would be -4 to 0. It is not possible for C_5H_{11} have negative or zero molecules. In patent examination, it is essential for claims to be precise, clear, correct, and unambiguous. *In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir., 1989). By deleting the phraseologies in every occurrence X the rejection would be overcome.

The proviso at the end of claim 21 is redundant and therefore claims 21-26, 33-39, 51-54, 59 are indefinite. The excluded compound is not within the scope of claim 21. By deleting the proviso the rejection would be overcome.

Response to Argument

Applicant's arguments filed 11/19/07 have been fully considered but they are not persuasive. Applicant contends that in the instant compounds R1 is a branched alkyl while in the prior arts it is a straight chain. Therefore, the anticipatory rejection is now withdrawn. However, the obviousness rejection stands since H and alkyl are art recognized equivalents. See the obviousness rejection in the last Office action. Applicant also argues that one of ordinary skill in the art would understand the various phraseologies above. This is not persuasive because the requirement of 35 USC 112, is not what is known or obvious to one of ordinary skill in the art but a "full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same", *Lookwood v. American Airlines Inc.* 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed Cir. 1997). See also the status.

Applicant further argues that due to the branching at R1, the instant compounds are more effective than prior arts compounds. This is not persuasive because applicant fails to support the assertion with conclusive evidence, such as, a side-by-side comparison. Applicant also argues that none of the prior arts suggests or discloses mixtures of the compounds. This argument is foreclosed by the recent decision in *KSR Int. Co. v. Teleflex Inc.*, 550 U.S. ----, 82 USPQ2d 1385 (2007).

Given the teachings of the prior arts, it would have been obvious to try various mixtures of the compounds at the time the invention was made.

When there is motivation

to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under [35 USC] 103.

KSR Int'l Co. v. Teleflex Inc., 127 S.Ct 1727,-----, 82 USPQ2d 1385, 1397 (2007).

Objection

Claims 21-27, 33-39, 44-59 are objected to for containing non-elected invention.

Applicant elected group I wherein X is S, O or NR5.

IDS

sodium hydroxide solution and optional warming. Such reactions are known to the person skilled in the art and are described in detail in the application, filed at the same time, with the title "Reaction products of 2-propylheptanol" (DE-A 102 46 140) using the example of 2-propylheptanol as nucleophile.

Above is not a discussion of the content of the cited reference. In addition there is no evidence the reference is published in English language. JP 62-114985 is not cited or discussed in the ISR.

Priority Claim

English translation of a priority document must be submitted when require by the examiner. While applicant may refuse to do so, such claim of priority may be denied by the Office.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD. JD., whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, can be reached on (571) 272-0867. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

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TAOFIQ SOLOLA
PRIMARY EXAMINER

Group 1625

December 26, 2007.